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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,374	10/30/2003	W. Bradley Wilkes	15790.2	7893
7590	12/30/2008			
R. BURNS ISRAELSEN WORKMAN NYDEGGER 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111				EXAMINER GREENE, DANIEL LAWSON
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 12/30/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/697,374	WILKES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL L. GREENE	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 September 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 12-34 is/are pending in the application.

4a) Of the above claim(s) 1-8, 13 and 22-34 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 9, 10, 12 and 15-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-34 were pending. Claims 1-8, 13, 14 and 22-24 were previously withdrawn from consideration in the previous Office action mailed 7/24/2008. In the response received 9/13/2008, applicant has amended several claims and cancelled claim 11. Accordingly an action on the merits of claims 9, 10, 12 and 15-21 follows.

***Response to Amendment***

2. Applicant's amendments to the claims and arguments in support thereof (see for example, section "C" spanning pages 9 and 10 of said response received 9/13/08) have obviated the rejection set forth in section 6 of said previous Office action. Accordingly, said rejection is hereby withdrawn.

***Response to Arguments***

3. Applicant's arguments filed 9/13/2008 have been fully considered but they are not persuasive.

**Applicant argues on page 11:**

"However, this section of the specification does not teach or suggest the electronic financial request having been generated by:

operatively connecting a portable transaction storage device with the transaction device, the portable transaction storage device containing merchant identifying information for a particular merchant stored thereon that can be selectively ported to the transaction device, wherein the transaction device is not permanently programmed to initiate transactions for the particular merchant such that the transaction device can be used to conduct financial transactions on behalf of any number of merchants;

As the cited section of the specification teaches, prior art point of sale terminals were pre-programmed with the merchant identification information, which limited the ways in which financial transactions could be performed. As recited in claim 9, a portable transaction storage device that allows multiple merchants to be able to receive payment through the transaction device is not taught or suggested in the cited section of the specification. As such, Applicant requests that the obviousness rejection to claim 9 based on pages 1-4 of the specification be withdrawn.”

**Response:**

Applicant’s arguments are unpersuasive as applicant has not shown that the references do not teach what the examiner has stated they teach, nor has applicant shown that the examiner’s reasoning for and manner of combining the teachings of the references is improper or invalid.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Per page 7 of the previous Office action, the Examiner set forth reasoning why one of ordinary skill in the art would be motivated to store the merchant information separately from the transaction device. (Reproduced below)

At the time of the invention it would have been obvious to one of ordinary skill in the art to have the merchant information stored separately from the transaction device and transaction data as such involves only "routine skill in the art" and does not produce any new or unexpected result. It would have also been obvious to do so for the benefit of additional security, because if the transaction device is stolen it cannot be used to make fraudulent charges since it has no merchant information stored therein.

Further, resort may be had to, for example, US 20010016835A1 to Hansmann et al. (hereinafter Hansmann) to show it is old and well known for SIM cards to securely store user specific data. See, for example, paragraph [0003], etc.

**[0003]** A very important cellular standard network is the so-called GSM (Groupe Special Mobile / Global system for mobile communications). Mobile stations under the GSM comprise the mobile equipment (cellular phone) itself and a so-called subscriber identity module (S ), the latter essentially consisting in a GSM specific chip card. The function of the SIM consists in ensuring that only authorized persons obtain access to the net, thus securing an operating call metering. To achieve this goal, the SIM securely stores user specific data (international mobile subscriber identity-IMSI) and executes a cryptographic algorithm under secure conditions.

Again, as explained by the Examiner in the previous Office action, separating the merchant information from the original system is WELL within the knowledge of one of ordinary skill in the art. This statement is further supported by Hansmann as set forth above. However in order for a financial transaction to be consummated there must be a

payor and a payee. Each party must have identifying information in order to direct funds to the appropriate party. Accordingly, if the information is not resident on the transaction device itself, it MUST be made available to the transaction device at some point in order to provide enough information to complete the transaction.

The limitations added to the claims are considered as being set forth in the previous Office action as well as being further supported by Hansmann.

Further, the same argument is applicable to the Templeton rejection set forth in section 10 of said previous Office action and Applicants arguments against such set forth on pages 11 and 12 of said received response.

Accordingly, the rejections set forth in said sections 9 and 10 of said previous Office action are sustained and incorporated herein by reference.

Even though it is considered that the application of case law to the references of record teaches applicant's inventive concept, for purposes of clarity, the Examiner has added the Hansmann reference to the rejections to further support that it was old and well known for SIM cards to contain such data.

4. **Examiner's Note:** The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in

entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Election/Restrictions***

5. This application contains claims 1-8, 13, 14 and 22-34 drawn to an invention nonelected with traverse in the reply filed on 4/21/2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 9, 10, 12 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of case law for the reasons set forth in section 9 of the previous office action mailed 7/24/2008 and further in view of US 2001/0016835 to Hansmann et al.**

See the discussion set forth in section 3 above.

8. **Claims 9-12 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/004772 A1 to Templeton et al. in view of case law for the reasons set forth in**

**section 10 of the previous office action mailed 7/24/2008 and further in view of US  
2001/0016835 to Hansmann et al.**

See the discussion set forth in section 3 above.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

/D. L. G./  
Examiner, Art Unit 3694  
2008-12-22